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| 10/092,924 | 03/08/2002 | Irwin Gerszberg | 003493.00363 | 2519 |
| 26652 | 7590 | 02/23/2006 | EXAMINER | |
| AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748 | | | ROBERTS, BRIAN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2662 | |

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,924

Applicant(s)

GERSZBERG ET AL.

Examiner

Brian Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-33 is/are pending in the application.
- 4a) Of the above claim(s) 23-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 15, 16 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 14 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- The Response to the Restriction Requirement filed 12/16/2005 is acknowledged.
- Claims 12-22 have been elected and examined.

Election/Restrictions

1. Applicant's election with traverse of group 1 in the reply filed on 12/16/2005 is acknowledged. The traversal is on the ground(s) that the examiner has not shown the inventions to be independent **and** distinct. This is not found persuasive because the inventions need to be shown to be either independent **or** distinct and not independent **and** distinct (MPEP § 802.01). The inventions of groups 1 and 2 are related as subcombinations usable in a single combination and are distinct because they are separately usable as described in the restriction requirement filed 11/16/2005.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 23 of U.S. Patent No. 6363079. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of the instant application broadens the scope of claims 15 and 23 of U.S. Patent No. 6363079.

Claim 12 of the instant application and claims 15 and 23 of U.S. Patent No. 6363079 recite:

- A controller
- A modem that modulates and demodulates the subscriber data to and from the subscriber link to generate a digital stream including the voice data, signaling data and user data
- A digital filter that separates the voice data from the digital stream,
- Said controller applying the voice data to the digital circuit when the signaling data indicates the voice data is to be transmitted by the digital circuit, and said controller applying the voice data to the digital network when the

signaling data indicates the voice data is to be transmitted over the digital network

- A DTMF generator; said interface being connected to a switched network requiring the transmission of DTMF tones for calls to be routed through the switched network
- Said DTMF generator generating DTMF tones in response to said signaling data indicated that the call is to be transmitted through the switched network

A claim 12 of the instant application does not recite a data storage unit, whereas claims 15 and 23 of U.S. Patent No. 6363079 recite a data storage unit.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

4. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 24 of U. S. Patent No. 6363079. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of the instant application broadens the scope of claims 15 and 24 of U. S. Patent No. 6363079.

Claim 13 of the instant application and claims 15 and 24 of U.S. Patent No. 6363079 recite:

- A controller
- A modem that modulates and demodulates the subscriber data to and from the subscriber link to generate a digital stream including the voice data, signaling data and user data
- A digital filter that separates the voice data from the digital stream wherein said controller applying the voice data to the digital circuit when the signaling data indicates the voice data is to be transmitted by the digital circuit, wherein said controller applying the voice data to the digital network when the signaling data indicates the voice data is to be transmitted over the digital network
- Wherein said controller communicates with a network controller of the digital network and generates a message to the network controller requesting reallocation of resources of the digital network in response to an end of transmission of the voice data

Claims 13 of the instant application does not recite a data storage unit, whereas claims 15 and 24 of U.S. Patent No. 6363079 recite a data storage unit.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

5. Claims 15-16 and 18-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U. S. Patent No. 6937595. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 15-16 and 18-19 of the instant application broaden the scope of claim 2 of U. S. Patent No. 6937595.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

6. Claim 22 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6937595. This is a double patenting rejection.

Claim 22 of the instant application and claim 3 of U.S. Patent No. 6937595 recite:

- A digital loop carrier with a digital interface to permit access to a digital backplane of said digital loop carrier;
- A controller with a modulator/demodulator configured to apply data corresponding to multiple voice call sessions from said link to said digital interface, and to apply data corresponding to said multiple voice call sessions from said digital interface to said link;
- Said multiple access link being established over a single twisted pair metallic interface;

- Said controller is connected to another digital network;
- Said controller is configured to add a new call in said multiple voice call session in response to signaling data received through said link, said controller being further configured to route selectively said new call through said another digital network responsively to signaling data received through said link;
- A data storage unit; and said controller being further configured to route said new call responsively to signaling data and subscriber data corresponding to said call, said subscriber data indicating services permitted for a calling party corresponding to said call

7. Claims 20 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6937595 in view of Nye et al. (US 6144659)

- In reference to claims 20 and 21

Claims 15 and 16, which claims 20 and 21 depend from, are substantially the same as claim 2 of U. S. Patent No. 6937595.

Claim 2 of USP 6937595 does not specify that a new call session may be a voice call session or a multimedia call session.

In Figure 2, Nye et al. teaches that a new call session may be a voice call session or a data call session.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the interface defined in claim 2 of USP 6937595 to allow the new calls session to be a voice call session or a data session in the manner as suggested by Nye because it reduces cost by allowing a single interface to serve both new voice and new multimedia call sessions.

Allowable Subject Matter

8. Claim 14 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Focsaneanu et al. (US 5991292) teaches a method of network access in a multi-service environment.
- Bremer et al. (US 6061392) teaches an apparatus and method for communicating voice and data between a customer premises and a central office.
- Bremer (US 6320879) teaches a communication system and method for interleaving or transmission of telephone rings and data.

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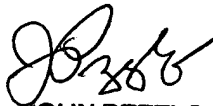
- Michaels (US 6466588) teaches apparatus for facilitating combined POTS and XDSL services at a customer premise.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Roberts whose telephone number is (571) 272-3095. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BSR
02/06/2006


JOHN PEZZLO
PRIMARY EXAMINER